

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY S. KRINTZMAN

Appeal No. 2003-2051
Application No. 09/127,183

ON BRIEF

Before ABRAMS, FRANKFORT, and McQUADE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 3-8, 10-15 and 23-25, which are all of the claims pending in this application.

We REVERSE AND REMAND TO THE EXAMINER.

BACKGROUND

The appellant's invention relates to an enhanced payout feature for gaming machines. An understanding of the invention can be derived from a reading of exemplary claim 23, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Smith III <u>et al.</u> (Smith)	4,504,062	Mar.12, 1985
UK Patent Application (McArthur)	2 211 975 A	Jul. 12, 1989

Claims 3-8 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by McArthur.

Claims 10-15, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McArthur in view of Smith.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 28) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 27) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant characterizes his invention as a gaming machine improvement that automates the technique of providing an enhanced payout to players for a limited period of time. According to the appellant, the promise of these enhanced awards operates as an incentive to gaming patrons to continue and to speed up play during the enhanced payout interval. See specification, pages 1-5.

Claim 23 sets forth the invention in the following manner:

In a gaming machine that makes a payout to a player in response to completion of a play cycle of the machine resulting in a payout event, the improvement comprising:

means for generating an enhanced payout signal at the end of an activity interval during which a frequency of play cycles of the machine is greater than a pre-selected minimum;

means for causing the machine to provide an enhanced payout to the player in concurrent response to said enhanced payout signal and completion of the play cycle of the machine resulting in said payout event; and

indicating means for indicating the existence of an enhanced payout interval to the player in response to said enhanced payout signal.

Independent claims 24 and 25 recite further embodiments of the invention which include constituent parts employed to prevent commencement of an enhanced payout interval based on machine idle time.

The Section 102 Rejection of Claims 3-8 and 23

Claims 3-8 and 23 stand rejected under 35 U.S.C. §102(b) as being anticipated¹ by McArthur. On page 4 of the Answer, the examiner has explained why, in his view, claim 23 is anticipated by McArthur. However, claim 23 contains means-plus-function limitations which must be evaluated in the context of the sixth paragraph of 35 U.S.C. §112 and, in order to meet a means-plus-function limitation, the prior art must perform the identical function recited in the means limitation and perform that function using the structure disclosed in the appellant's specification or an equivalent structure. See Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir 1993). The examiner's rejection does not provide such an analysis.

In this regard, independent claim 23 recites (1) "means for generating an enhanced payout signal at the end of an activity interval . . . ,", (2) "means for causing the machine to provide an enhanced payout to the player . . . ,", and (3) "indicating means for indicating the existence of an enhanced payout to the player" In the description of the preferred embodiments of the invention which is set forth in the

¹The guidance provided by our reviewing court with regard to the matter of anticipation is as follows: Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, e.g., In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Additionally, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). Nor does it require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

specification, beginning at page 14, the appellant has set forth structure that accomplishes these means-plus-function limitations. However, as has been pointed out by the appellant, the examiner has not made findings and determinations in accordance with the guidance provided by our reviewing court and as directed by Sections 2181-2184 of the Manual of Patent Examining Procedure. In this regard, the examiner has not established in posing the rejection that each means-plus-function limitation in each of the rejected claims is met by the prior art, that is, that the system disclosed in the McArthur patent performs the identical functions recited in the means-plus-function limitations recited in claim 23 (Answer, pages 4 and 5). This fundamental shortcoming causes the rejection not to be sustainable.

However, even if one were to consider, arguendo, that the three functions in the claim are performed by the McArthur system, the rejection still would be fatally defective, for the examiner has not determined whether these functions are performed by structure that is the same as, or equivalent to, the structure disclosed by the appellant in the specification. In this regard, we point out that such determinations are not present in the statement of the rejection on pages 4 and 5 of the Answer, nor have they been provided in the response to the appellant's arguments on this subject on pages 7-12 of the Brief. As to the question of whether the means is the same, the examiner has not compared the structure disclosed by McArthur with that presented by the appellant in the specification, and has not found that they are the same. Moreover,

our review of the McArthur disclosure reveals the statement that “the technology required to implement any of the various methods and apparatus described . . . will be well known to those skilled in the art” (page 10), which indicates that sufficient description of the structure as to enable such a comparison to be made is not provided in the patent.

The same applies to the matter of equivalency. While there is no litmus test for an “equivalent” that can be applied with absolute certainty and predictability, there are several indicia that are sufficient to support a conclusion of equivalency or non-equivalency. These include:

(1) Whether the prior art elements perform the function specified in the claim in substantially the same way, and produce substantially the same results as the corresponding structure disclosed in the specification. Odetics Inc. v. Storage Tech. Corp., 185 F.3d 1259, 1267, 51 USPQ2d 1225, 1229-30 (Fed. Cir. 1999).

(2) Whether a person of ordinary skill in the art would have recognized the interchangeability of the elements shown in the prior art for the corresponding elements disclosed in the specification. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 1316, 50 USPQ2d 1161, 1165 (Fed. Cir. 1999).

(3) Whether the prior art elements are the structural equivalents of the corresponding elements disclosed in the specification. In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

(4) Whether there are insubstantial differences between the prior art elements and the corresponding elements disclosed in the specification. IMS Technology, Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1436, 54 USPQ2d 1129, 1138-39 (Fed. Cir. 2000).

There is nothing in the record which would support answering any of the above questions in the affirmative, and thus there is no support for concluding that the prior art structure is the equivalent under 35 U.S.C. § 112, sixth paragraph, of the structure disclosed by the appellant in the specification.

For the reasons expressed above, the rejection of independent claim 23 as being anticipated by McArthur cannot be sustained. Nor, it follows, can we sustain the like rejection of claims 3-8, which depend from claim 23.

The Section 103 Rejection Of Claims 10-15, 24 and 25

Independent claim 24, dependent claims 10-15, and independent claim 25 stand rejected as being obvious² in view of the combined teachings of McArthur and Smith. Claim 24 recites, inter alia, (1) “means for generating a reset pulse, delayed by an enhanced payout interval, in response to said enhanced payout signal,” (2) “resetting means for resetting said activity counter in response to said idle time signal and in response to said reset pulse,” and (3) “indicating means for indicating the existence of said enhanced payout interval to the player in response to said enhanced payout signal.” As was the case with Claim 23, the examiner has failed to treat these

²The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant’s disclosure. Uniroyal, Inc. V. Rudkin-wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

limitations in the manner required under the sixth paragraph of 35 U.S.C. §112. This being the case, the rejection cannot be sustained for the same reasons as were applied against the rejection of claim 23. It follows that the like rejection of claims 10-15, which depend from claim 24, cannot be sustained.

This conclusion is not altered by consideration of Smith, which was applied for teaching that games having idle time counters that reset the game to a starting mode after the expiration of a preset time were known in the art at the time of the appellant's invention. In passing, we wish further to point out that the examiner has not directed us to evidence in the applied references or elsewhere which supports the conclusion that it would have been obvious to one of ordinary skill in the art to add an idle time counter to the McArthur system "to provide a more efficient reset method," as has been asserted on page 6 of the Answer.

Claim 25 recites means for preventing an enhanced payout interval in response to an idle time signal. As was the case with claims 23 and 24, the examiner has not met the burden necessary to reject claims containing means-plus-function limitations, and therefore the rejection of claim 25 also cannot be sustained.

Remand To The Examiner

Acres et al. U.S. Patent No. 6,162,122,³ which has come to our attention, is directed to a method and apparatus for operating networked gaming devices. This patent discloses a system for automating gaming device configurations to make them more attractive to players by reconfiguring them under certain circumstances to provide an additional incentive to players to use the devices (column 2, lines 7-26). The reconfiguration activates a bonus payout schedule as a result of tracking such factors as the number of coins deposited by a player, the time the player has spent at the machine, and the number of coins won and games played (column 3, lines 1-46). Thus, it would appear that the objectives of the Acres system are similar to those of the appellant's invention. Structure for accomplishing these objectives is described in the patent.

This application is remanded to the examiner for evaluation of the patentability of the appellant's claims in view of the teachings of Acres. In considering this matter, the attention of the examiner is directed to the discussions relating to rejecting claims containing means-plus-function limitations which appear in the Manual of Patent Examining Procedure.

CONCLUSION

Neither rejection is sustained.

The decision of the examiner is reversed.

³Copy enclosed.

The application is remanded to the examiner for action in accordance with the comments set forth above.

REVERSED AND REMANDED

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

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Appeal No. 03-2051
Application No. 09/127,183

Page 12

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